



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Waterford Wines (Proprietary) Limited,

Opposer,

vs.

Waterford Wedgwood Plc,

Applicant.

78972993
Opposition No. 91180312



12-05-2007

U.S. Patent & TMO/TM Mail Rpt. Dt. #72

APPLICANT'S MOTION TO SUSPEND PROCEEDINGS

Pursuant to TBMP Section 510.02(a), Applicant Waterford Wedgwood Plc ("Applicant") respectfully requests suspension of the proceedings pending resolution of *Waterford Wedgwood Plc, et al. v. Waterford Wines (PTY) Ltd. et al.*, Civil Action No. 07-208 (FLW)(JJH) in the United States District Court for the District of New Jersey (the "District Court Action").

Pursuant to TBMP Section 510.02(a), the Board may suspend proceedings whenever it comes to the attention of the Board that a civil action is pending which may have a bearing on the Board case. The District Court Action contains claims of trademark infringement and unfair competition and concerns the respective rights of the very same parties to this opposition proceeding, namely Waterford Wines (Proprietary) Limited and Waterford Wedgwood Plc, to the WATERFORD mark with respect to alcoholic beverages, which are covered in the Application at issue in this Opposition proceeding. A copy of the Complaint is attached as Exhibit A. In such instances, suspension of opposition proceedings is appropriate. E.g., General Motors Corp. v Cadillac Club Fashions, Inc., 22 U.S.P.Q. 2d 1933 (TTAB 1992).

Thus, a final disposition of the District Court Action may have a direct bearing on this opposition proceeding. As such, Applicant respectfully requests that the Trademark Trial and

Appeal Board suspend this opposition proceeding pending resolution of the District Court Action.

CONCLUSION

For the reasons set forth above, Registrant respectfully requests that pursuant to TBMP Section 510.02(a) the Board suspend this proceeding pending the resolution of Civil Action No. 07-208 (FLW)(JJH) in the U.S. District Court of New Jersey.

Respectfully submitted,

Waterford Wedgwood Plc

By


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12/5/17

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing APPLICANT'S MOTION TO SUSPEND PROCEEDINGS was served on counsel for Opposer, this 5th day of December, 2007 by sending same via first-class mail, postage prepaid, to:

Evan Gourvitz, Esquire
Fross Zelnick Lehrman & Zissu, P.C.
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New York, New York 10017

A handwritten signature in cursive script, reading "Florence Goodman", written over a horizontal line.

Florence Goodman

EXHIBIT A

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Waterford Wedgwood USA, Inc.*

**UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY**

Waterford Wedgwood Plc. and)	
Waterford Wedgwood USA, Inc.)	<u>DOCUMENT ELECTRONICALLY FILED</u>
)	
Plaintiffs,)	CIVIL ACTION NO. 07-208 (FLW)(JJH)
)	
v.)	
)	FIRST AMENDED COMPLAINT
Waterford Wines (pty) Ltd., Waterford)	WITH JURY DEMAND
Wine Estate, Waterford Stellenbosch,)	
Assembled Investments (pty) Ltd.,)	
Yellowwood Wine Company, LLC., and)	
T. Edward Wines Ltd.)	
)	
Defendants.)	
)	
)	

Plaintiffs Waterford Wedgwood Plc. and Waterford Wedgwood USA, Inc. by and through their undersigned attorneys, for their Complaint against Defendants allege as follows:

PARTIES

1. Plaintiff Waterford Wedgwood Plc. ("Waterford") is a limited corporation organized and existing under the laws of Ireland, is publicly traded on the Irish and London Stock Exchanges, and has its principal place of business at Kilbarry, Waterford, Ireland.

2. Plaintiff Waterford Wedgwood, USA, Inc. ("Waterford USA" and collectively with Waterford, "Plaintiffs") is a corporation organized and existing under the laws of the state of New York and has its principal place of business at 1330 Campus Parkway, Neptune, New Jersey 07753. Waterford USA is a subsidiary and licensee of Waterford.

3. On information and belief, Defendant Waterford Wines (pty) Ltd. is a foreign corporation organized and existing under the laws of the South Africa having its principal place of business located at Blaauwklippen Road, P.O. Box 635, Stellenbosch, 7599, South Africa.

4. On information and belief, Defendant Waterford Wine Estate, is an entity related to Waterford Wines (Pty) Ltd., having its principal place of business located at Blaauwklippen Road, P.O. Box 635, Stellenbosch, 7599, South Africa.

5. On information and belief, Defendant Waterford Stellenbosch is an entity related to Waterford Wines (Pty) Ltd. and Waterford Wine Estate, having its principal place of business located at Blaauwklippen Road, P.O. Box 635, Stellenbosch, 7599, South Africa.

6. On information and belief, Defendant Assembled Investments (pty) Ltd. (hereinafter collectively with Waterford Wines (pty) Ltd., Waterford Wine

Estate, and Waterford Stellenbosch; "Stellenbosch") is an entity related to Waterford Wines (Pty) Ltd., Waterford Wine Estate, and Waterford Stellenbosch, having its principal place of business located at Blaauwklippen Road, P.O. Box 635, Stellenbosch, 7599, South Africa.

7. On information and belief, Defendant Stellenbosch regularly conduct business through distributors.

8. On information and belief, Defendant Yellowwood Wine Company, LLC. (hereinafter "Yellowwood") is a company organized and existing under the laws of the State of California having its principal place of business at 1517 North Point, #537, San Francisco, California 94123.

9. On information and belief, Yellowwood has partnered with Stellenbosch to be the United States distributor for Stellenbosch as is listed on the Waterford Wine's website at www.waterfordwines.com and per a Yellowwood News Announcement of September 2003.

10. Printouts from Defendant Stellenbosch's Web site are annexed hereto as Exhibit A.

11. Printouts from Defendant Yellowwood's Web site announcing its' partnership with Stellenbosch of September 2003 are annexed hereto as Exhibits B-C.

12. On information and belief, Yellowwood regularly conducts business through distributors.

13. On information and belief, Defendant T. Edward Wines Ltd. (hereinafter "T. Edward" and collectively with Stellenbosch and Yellowwood, "Defendants") is a foreign for profit corporation having a registered agent in North Bergen, New Jersey and having its principal place of business at 66 Dryden Road, Upper Montclair, New Jersey 07043.

14. On information and belief, Defendant T. Edward is the New Jersey local distributor for Yellowwood as is listed on Yellowwood's website at www.yellowwoodwineco.com and per a Yellowwood News Announcement of December 2003.

15. Printouts from Defendant Yellowwood's Web site announcing T. Edward as a distributor of Yellowwood are annexed hereto as Exhibit D.

16. Printouts from Defendant Yellowwood's Web site are annexed hereto as Exhibit E.

17. On information and belief, T. Edward is a distributor of the Stellenbosch "Waterford" brand as listed on the T. Edward's website at www.tedwardwines.com.

18. Printouts from Defendant T. Edward's Web site is annexed hereto as Exhibits F-G.

JURISDICTION AND VENUE

19. This action arises under the Lanham Act, 15 U.S.C. § 1051, et seq., New Jersey Statute Annotated §§ 56:3-13.16, 56:3-13.20, and 56:4-1, and the common law of the State of New Jersey.

20. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1338, and 1367(a), and 15 U.S.C. § 1121(a).

21. This Court has personal jurisdiction over Defendants because Defendants have committed and threatens to commit trademark infringement, trade name infringement, unfair competition, dilution, and other torts in the United States and in this district; Defendants have caused injury to Plaintiffs and their property in the United States and in this district; and Defendants purposely and directly has targeted its activities at the United States and at this district.

22. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b) and (c).

PLAINTIFF'S TRADEMARKS

23. Plaintiff Waterford is a recognized world leader in the manufacture and merchandizing of crystal, china and other fine items. Such goods are sold by Plaintiffs and their affiliates under Waterford's famous WATERFORD mark (the "WATERFORD Mark"), which has been in use in United States commerce since at least as early as 1952.

24. Plaintiff Waterford is the owner of U.S. Registration No. 2805962 on the Supplemental Register for the mark WATERFORD VINEYARDS for "wine" based on use in commerce since September 6, 2002. Waterford also owns U.S. Application No. 78/580,107 on the Principal Register for WATERFORD VINEYARDS for "wine," based on use in commerce since September 6, 2002, and all common law rights in and to the mark described therein. True and correct copies of printouts from the United States Patent and Trademark Office's

Trademark Applications and Registrations Retrieval Database, listing the application and registration details for the foregoing registrations are annexed hereto as Exhibits H-J.

25. Plaintiff Waterford is the owner of numerous registrations throughout the world for its WATERFORD Mark, including United States Registration Nos. 0951941, 1098077, 1309714, 1309956, 1414135, 1417635, 1459173, 1459373, 1562086, 1562118, 1562487, 1566992, 1577340, 1598644, 1744890, 2166133, 2203273, 2203274, 2239473, 2355690, 2355876, 2393891, 2402350, 2788341, 2860652, 2898833, 2993101, 3043212, 3056140, and 3071703. True and correct copies of printouts from the United States Patent and Trademark Office's Trademark Applications and Registrations Retrieval Database, listing the registration details for the foregoing registrations are annexed hereto as Exhibits K-NN.

26. The WATERFORD Mark is federally registered in relation to wines and a wide range of glassware for use in connection with alcoholic beverages, including but not limited to stemware, tumblers, and hi-ball glasses. Among Waterford's registrations for such goods are United States Registration Nos. 0951941, 2355690, 2402350 and 2860652. Each of those registrations enjoys the benefits of incontestability pursuant to § 15 of the Lanham Act, 15 U.S.C. § 1065.

27. Among Plaintiffs' WATERFORD branded goods are an array of goods synonymous with the wine and liquor industry, including wine glasses, martini glasses, martini pitchers, shot glasses, tumblers, hi-ball glasses, cordial glasses, champagne flutes, decanters, and ice buckets.

28. By virtue of more than fifty (50) years of continuous and substantially exclusive use, as well as Plaintiffs' and their affiliates' expenditure of millions of dollars in advertising and promotion, the WATERFORD Mark has become famous and has come to symbolize extensive goodwill throughout the United States. The WATERFORD Mark is recognized the world over as identifying high quality goods associated with Plaintiffs.

COUNT I
TRADEMARK INFRINGEMENT UNDER FEDERAL LAW

29. Paragraphs 1-28, above, are realleged and incorporated by reference as if set forth in full herein.

30. On information and belief, Stellenbosch and Yellowwood, without Plaintiffs' permission, have been using the WATERFORD Mark in commerce since at least as early as September 2003.

31. On information and belief, T. Edwards, without Plaintiffs' permission, has been using the WATERFORD Mark in commerce since as early as December 2003.

32. On information and belief, Stellenbosch, without Waterford's permission, has been using the WATERFORD Mark on wine labels, as a brand of wine, as well as on its' Web site posted at www.waterfordwines.com, and in other ways customary in the trade.

33. Printouts from Stellenbosch's Web site showing Defendant's unauthorized use of WATERFORD are annexed hereto as Exhibit A.

34. On information and belief, Yellowwood has partnered with Stellenbosch and has been importing, distributing, and selling wine from Stellenbosch bearing the WATERFORD Mark as well as displaying the WATERFORD Mark on its Web site posted at www.yellowwoodwineco.com.

35. Printouts from Yellowwood's Web site are annexed hereto as Exhibits B-C.

36. On information and belief, T. Edward receives wine from Yellowwood bearing the WATERFORD Mark, which it sells within New Jersey, and displays the WATERFORD Mark on its' Web site posted at www.tedwardwines.com.

37. Printouts from Yellowwood's Web site announcing T. Edward as a distributor of Yellowwood are annexed hereto as Exhibits D-E.

38. Printouts from T. Edward's Web site is annexed hereto as Exhibit F-G.

39. Defendants' use and threatened continued use of WATERFORD is likely to cause confusion, to cause mistake and to deceive as to the source, origin or sponsorship of Defendants' goods.

40. On information and belief, Defendants' acts of infringement were and continue to be intentionally and knowingly in violation of Plaintiffs' rights.

41. Defendants' wrongful acts are continuing and ongoing.

42. On information and belief, Defendants will not cease committing the wrongful acts alleged in this Complaint without the intervention and injunction of this Court.

43. Defendants' use and threatened continued use of WATERFORD is likely to cause the public wrongly to associate Plaintiffs with Defendants, to believe

that Plaintiffs are somehow affiliated or connected with Defendants, to believe that Plaintiffs are somehow affiliated or connected with Defendants, or to confuse Defendants and its goods with those of Plaintiffs.

44. Defendants' use and threatened continued use of WATERFORD has caused and threatens Plaintiffs with irreparable injury for which they have no adequate remedy at law.

45. Defendants' use of WATERFORD has unjustly enriched Defendants.

46. Defendants' acts are in violation of Waterford's rights under the Lanham Act, including 15 U.S.C. § 1114.

47. Defendants are liable to Waterford for trademark infringement under §§ 32, 34 and 35 of the Lanham Act, 15 U.S.C. §§ 1114, 1116 and 1117.

COUNT II
UNFAIR COMPETITION AND FALSE DESIGNATION OF ORIGIN
UNDER FEDERAL LAW

48. Paragraphs 1-47, above, are realleged and incorporated by reference as if set forth in full herein.

49. Defendants are liable to Plaintiffs for violation of § 43(a) of the Lanham Act, 15 U.S.C. § 1125 (a).

COUNT III
TRADEMARK DILUTION UNDER FEDERAL LAW

50. Paragraphs 1-49, above, are realleged and incorporated by reference as if set forth in full herein.

51. The WATERFORD Mark is a famous mark within the meaning of 15 U.S.C. § 1125(c), and was famous long before Defendants' wrongful adoption of the trademark WATERFORD.

52. Defendants' unauthorized use of the WATERFORD Mark is likely to dilute the distinctive quality of Waterford's WATERFORD Mark.

53. Defendants are liable to Waterford for dilution in violation of § 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

COUNT IV
TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION
UNDER NEW JERSEY STATE LAW

54. Paragraphs 1-53, above, are realleged and incorporated by reference as if set forth in full herein.

55. Plaintiffs have used and continue to use the WATERFORD Mark in the State of New Jersey in connection with the sale of goods and services.

56. The WATERFORD Mark has been used to signify Waterford as the source of the goods or services rendered in the State of New Jersey.

57. Defendants have intentionally and willfully used the WATERFORD trademark in connection with its promotion of goods directed at citizens of New Jersey, without authorization from Waterford.

58. Defendants' use of the WATERFORD Mark violates New Jersey Statute Annotated § 56:3-13.16 and 56:4-1.

COUNT V
DILUTION UNDER NEW JERSEY STATE LAW

59. Paragraphs 1-58, above, are realleged and incorporated by reference as if set forth in full herein.

60. Defendants' use of the WATERFORD Mark violates New Jersey Statute Annotated § 56:3-13.20.

COUNT VI
COMMON LAW TRADEMARK INFRINGEMENT

61. Paragraphs 1-60, above, are realleged and incorporated by reference as if set forth in full herein.

62. Defendants are liable to Plaintiffs for trademark infringement under the common law of the state of New Jersey.

WHEREFORE, Plaintiffs pray that the Court:

- A. grant preliminary and permanent injunctions against Defendants' threatened acts of trademark infringement, unfair competition and dilution;
- B declare, adjudge and decree that Defendants' use and threatened continued use of the WATERFORD Mark constitutes trademark infringement, unfair competition and dilution;
- C. order Defendant to (i) destroy all signage at its place(s) of business, all labels, product packaging, advertising materials, and other materials that display the WATERFORD Mark, (ii) turn over to the Plaintiffs all

promotional and other material in their possession bearing the WATERFORD Mark, and (iii) provide an affidavit attesting to compliance with the requirements of this paragraph;

- D. Award Plaintiffs compensatory damages as provided by law;
- E. Award Plaintiffs punitive damages as provided by law;
- F. Award Plaintiffs their costs, disbursements and attorney fees incurred in bringing this action; and
- G. Award Plaintiffs such other and further relief as the Court may deem just and proper.

JURY DEMAND

Plaintiffs requests a trial by jury on all issues so triable.

Respectfully submitted,

Dated: August 24, 2007

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